

REMARKS/ARGUMENTS

Claims 1-3 and 6-11 are now pending, a total of 9 claims. Claims 1-3 and 6-11 have been rejected under 35 U.S.C. § 103(a).

Independent claims 1 and 9 are currently amended. Dependent claim 2 is canceled without prejudice. Dependent claims 3, 6-8, 10 and 11 are unamended. Claims 4 and 5 were previously canceled.

Applicant respectfully requests reconsideration of the application.

Applicant believes that the claims as currently presented have sufficient antecedent basis for all terms used therein, and that they particularly point out and distinctly claim the subject matter of the invention. As shown below, the pending claims are not anticipated, taught, or suggested by any of the references of record.

I. Claims 1-3 and 6-10

Claims 1-3 and 6-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Trull et al. (U.S. 6,080,136) in view of Ito (U.S. 5,063, 025).

Independent claims 1 and 9 are currently amended.

Dependent claim 2 is canceled without prejudice.

The Trull et al. reference does not teach or suggest the claimed invention. As the Examiner has acknowledged, Trull et al. does not disclose the hardness of the gasket being between 55 to 60 when measured by a JIS hardness meter. Nor is there any disclosure of a surface of the gasket laminated with a polyethylene fluoride resin.

With reference to a completely different field of endeavor, and different problems to be solved, the Ito reference teaches that a "linear plunger formed of superelastic wire"

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(column 3, line 32-34, and claims 1-8) is used in "an analytical microsyringe [for] gas chromatography and liquid chromatography." (Column 1, lines 7-9.) Ito's linear plunger made of superelastic wire is not analogous art. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). Indeed, Ito's use of superelastic material explicitly teaches away from a gasket made of a hard material.

In addition, Ito applies a protective coating to the plunger only to preclude the corrosive effects of the chemicals, such as hydrochloric acid, sulfuric acid and other non-oxidizable acids, that are analyzed using the Ito microsyringe. (Column 4, lines 44-53; column 5, 39-42.) To facilitate the sliding operation of the microsyringe, the Ito plunger is configured to have a large-diameter portion and a small-diameter portion. (Column 4, lines 54-66; column 5, line 42 to column 6, line 2.)

Further, Applicant respectfully submits that the Examiner has identified no teaching or suggestion in the prior art to modify the Trull et al. gasket with a superelastic linear plunger as taught in Ito. Nor is there any teaching or suggestion in the art to combine Trull et al. and Ito with Akaike et al. – the three references applied by the Examiner to reject dependent Claim 2. Thus, no prima facie showing of obviousness has been made, and amended claims 1 and 9, are patentable over the references of record. Dependent claims 3, 6, 7, 8 and 10 are patentable with independent claims 1 and 9.

II. Claim 11

Multiple dependent claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Trull et al. (U.S. 6,080,136), as modified by Ito (U.S. 5,063, 025), and in further view of Higashikawa (U.S. 5,830,193).

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Multiple dependent claim 11 is patentable with independent claims 1 and 9, as discussed above, and recites additional features that further distinguish the invention from the prior art.

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In view of the foregoing, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

FROM WILLKIE FARR 37 FAX DEPT

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Enclosed herewith is a Request for Continued Examination (RCE) transmittal (2 copies) and a Petition for Extension of Time for five (5) months.

Respectfully submitted,

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Dated: January 24, 2005

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